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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/578,484

08/14/2006

Krister Hansson

TPP 32002

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10/16/2008

NOVAK, DRUCE + QUIGG L.L.P. - PERGO

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EXAMINER

ORLANDO, MICHAEL N

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

10/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/578,484

**Applicant(s)**

HANSSON ET AL.

**Examiner**

MICHAEL N. ORLANDO

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 08 May 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 05/08/2006  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 recites the limitation "the at least one overlay paper" in line 1. There is insufficient antecedent basis for this limitation in the claim. There is no mention of a previous overlay paper. For examination purposes the position is taken that the wear layer is the overlay paper.
3. Claims 17-19 recites the limitation "a second camera" in line 3. There is insufficient antecedent basis for this limitation in the claim. There is no mention of a first camera in either of claim 17 or claim 1 from which it depends.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6, 7, 9, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Giertz et al. (EP 1,153,736).

Regarding claim 1, Giertz discloses a process for the manufacture of a decorative board with thermosetting resin impregnated layers and a décor paper in the form of a sheet. The décor paper is placed on a surface of a base layer and bonded thereto by pressing under heat and pressure. The pressing utilizes a matrix (press foil)

with a surface structure coinciding with the intended décor pattern and such is accurately placed on top of the decor paper before pressing and separated after pressing to obtain the desired decor surface (abstract). The matrix is further defined as either a plate or a press foil ([0009]). Giertz discloses that the structure foil web can be cut into sheets (i.e. multiple press foils) and positioned on the décor web.

Regarding claims 2 and 3, Giertz discloses adding an overlay paper as the surface layer of the laminate to increase wear resistance whereby such is impregnated with melamine-formaldehyde and contains hard particles with average sizes of 1-100um ([0013]). The impregnation of the sheet coating of hard particles makes up the sheet. The sheet is used during the lamination procedure as a cover layer as seen in figure 1 (reference 5 is the impregnated overlay).

Regarding claim 6, suitable base layers of used in the invention of Giertz include fiber board or particle board ([0008]).

Regarding claim 7, the base layer sheets of Giertz are impregnated with phenol-formaldehyde resin ([0016]).

Regarding claims 9-10, Giertz discloses a suitable décor pattern whereby there is rows of bars and those bars are offset in the longitudinal direction. Sections of bars can either be parallel to the longitudinal direction or perpendicular (i.e. latitudinal) ([0011]).

Regarding claim 13, the décor paper of Giertz have positioning means such as color dots holed and indentations ([0010]).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 4-5, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giertz et al. (EP 1,153,736).

Regarding claims 4 and 5, Giertz discloses adding an overlay paper as the surface layer of the laminate to increase wear resistance whereby such is impregnated with melamine-formaldehyde and contains hard particles with average sizes of 1-100um ([0013]). Giertz does not explicitly teach the particle ranges of 50nm-150um or 50nm to 30um.

Clearly the disclosed range of 1-100um substantially overlaps the claimed ranges and the courts have held that in cases where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). It would have therefore been obvious to utilize the claimed ranges.

Regarding claims 11-12, as indicated above Giertz discloses a suitable décor pattern whereby there is rows of bars and those bars are offset in the longitudinal direction. Sections of bars can either be parallel to the longitudinal direction or perpendicular (i.e. latitudinal) ([0011]). Giertz does not explicitly state that such results in rectangle and/or square panels; however, it is clear that perpendicularly related bars cross at right angles (perpendicular indicates such) and given such the repeating pattern would produce a meshed design with varying rectangles and/or squares based upon the spacing of the alternate (i.e. longitudinal and latitudinal) bars. Modifying the spacing to ensure such a specific type of rectangle (i.e. a square) is merely a design choice and within the purview of an ordinary skilled artisan. Also note that courts have held that features relating to ornamentation cannot be relied upon to patentably

distinguish the claimed invention from the prior art (In re Seid, 161 F.2d 229, 73 USPQ 431, CCPA 1947).

5. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giertz et al. (EP 1,153,736), as applied to the claims above, and further in view of Sjoberg et al. (US 2003/0183334).

Regarding claims 8 and 14, the method of claim 1 is presented above as are the merits of claim 14 excluding the camera array. Giertz fails to teach an automated means for arranging foils and subsequently an automated means for performing the process of claim 1 as set forth above.

Sjoberg, drawn also to a process for the manufacture of a decorative laminate, discloses the use of vision systems and sensors such as cameras for use in the lamination process ([0019]). It would have been obvious to one having ordinary skill in the art at the time of the invention to have utilized the vision systems and sensors of Sjoberg with the invention of Giertz because such was known for allowing the identification of certain features for proper positioning and subsequent result of achieving an accurate match between the decor and surface structure ([0019]). The process itself is disclosed and in view of Sjoberg the automated alignment and execution of process steps is also known. Further tailoring and/or providing alternative automated means to satisfy the steps of the process that is already disclosed by Giertz/Sjoberg is a matter of obviousness since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

6. Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giertz et al. (EP 1,153,736), and Sjoberg et al. (US 2003/0183334), as applied to the claims above, and further in view of Garcia (US 2003/0205012).

Regarding claims 15-19, it is noted that Sjoberg also appreciates the inclusion of various cutting, aligning and joining steps that allow the ability to control the final design ([0024], [0028]). Since Sjoberg discloses the use of cutting, aligning and joining features to produce desired final designs of a decorative board it would have been an obvious matter to cut, align and join components so as to arrive at the desired design. Further evidencing the assertion of obviousness is the teachings of Garcia whereby it is disclosed that in the art of decorated laminates useful in flooring (the same general field of endeavor as both Sjoberg and Giertz) it was known to create a decorative substrate, cut the substrate into smaller pieces and accurately align then via the use of cutting, shaping and milling tools followed by the addition of alignment features for joining the individual subsets (i.e. panels) ([0058]). It would have been obvious to utilize the method of Garcia with the teachings of Giertz and Sjoberg as disclosed above because Garcia is from the same field of endeavor and signifies the knowledge in the art prior to the applicant's invention. An ordinary skilled artisan would have also been motivated to utilize the teachings of Garcia because the smaller panels would be predictably easier to package, store and ship so that they may be assembled at when and where assembly is desired. Also, as to the specific use of two cameras with one detecting structure and the other color it is noted that Sjoberg recognizes the use of vision systems that can be used to identify structure and decor (color being a subset of decor)



((0010)) and combining multiple imaging systems as set forth by Sjoberg would have been obvious in order to increase the precision of the alignment. Sjoberg also recognizes the importance of accurate matches (i.e. alignments) between the décor and structure surfaces ((0019)) so therefore it would have been obvious to visually inspect the laminate alignments to assure that the desired level of accuracy is achieved and the use of a computer for performing said task is an obvious matter since it has been held that merely applying a general mechanical or automatic means (computer inspection) to replace manual activity (visual inspection) which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL N. ORLANDO whose telephone number is (571)270-5038. The examiner can normally be reached on Monday-Thursday, 7:30am-4:30pm, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MO

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791